Panel Decision for dispute CAC-ADREU-001491

Case number	CAC-ADREU-001491
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Domain names	musicroom.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Music Sales Limited, Mr George Goble

Respondent

Organization / Name	EURid

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

On 12 January 2006, an application was made in the name “The Music Sales Group” for registration of the domain name <musicroom.eu> during the first phase of the sunrise registration period. In the application, the address was stated as “8-9 Frith Street, W1D 3JB, London W1D 3JB”.

The prior right field stated: “Company name: Musicroom.com Ltd, CTM in EU for "Music Room", domain names musicroom.com, musicroom.co.uk, musicroom.fr, musicroom.de etc.”

The Respondent received supporting documentary evidence on 15 February 2006, before the 21 February 2006 deadline. The evidence consisted of an online printout from the Office of Harmonization for the Internal Market for Community Trade Mark 002401735 for the words “MUSIC ROOM” registered 1 April 2003 (“the CTM”). The printout gave the name of the trade mark owner as “Music Sales Limited” with the same address as that shown on the domain name application except that the postcode was different - W1V 5TZ.

On 25 April 2006, the Respondent rejected the application on the grounds that the evidence received was insufficient to demonstrate the existence of the right claimed.

A. COMPLAINANT

The disputed domain name is identical to the above registered Community Trade Mark of which the Complainant is the proprietor. The documentary evidence submitted clearly shows that the Complainant is the reported owner of the trade mark, according to the provisions of Section 13(2) of the .eu Sunrise Rules.

“The Music Sales Group” is a trading name which encompasses the Complainant. Evidence that “The Music Sales Group” is an umbrella trading name is shown by the Complainant’s headed paper. An application in the name of The Music Sales Group is effectively the same as an application in the name of the Complainant.

The Respondent may have rejected the documentary evidence of the Community Trade Mark because the postcodes of the Complainant and The Music Sales Group were different. This is because the postcodes for the area in London where the Complainant’s office is based were reorganized.

The Companies House record for Musicroom.com Ltd, which was mentioned under “prior rights” in the sunrise application, shows that

this company's registered office is care of the Complainant.

Whois printouts for two of domain names mentioned under "prior rights" show that the Complainant owns musicroom.co.uk and "The Music Sales Group" owns musicroom.com.

In accordance with Section 11(3) of the .eu Sunrise Rules, the Complainant was clearly the holder of all cited prior rights by the date of application for the disputed domain name.

In case 00396, it was held that the domain name "CAPRI" should be attributed to the applicant, even where the application was not accurate in many respects (name of the applicant, seat of the applicant and form of the applicant).

The Complainant seeks annulment of the disputed decision by the Respondent and attribution to the Complainant.

B. RESPONDENT

The documentary evidence did not demonstrate that "The Music Room Group" was the holder of a prior right. The burden of proof is on the applicant. It is of crucial importance that the Respondent is provided with all the documentary evidence necessary for it to assess if the applicant is indeed the holder of a prior right.

The relevant question is not whether an applicant is the holder of a prior right but whether an applicant fully proves to the validation agent that it is the holder of a prior right.

The documentary evidence did not demonstrate that applicant was entitled to the trade mark. The applicant name was different to the name of the Complainant. In such case, Article 20 (3) of the Sunrise Rules provides that the applicant must submit official documents substantiating that it is the same person as, or the legal successor, to the person indicated in the documentary evidence as being the holder or licensee of the prior right.

Here there was no explanation in the documentary evidence for the difference between the names of the applicant and trade mark owner. The Respondent cannot be expected to speculate on their relationship and therefore correctly rejected the application.

The Complainant now argues that the applicant's name is a trading name for a group of companies and that an application in the name of the applicant equates to an application in the name of the Complainant (which allegedly forms part of that group). No evidence was provided to the validation agent to that regard, whereas such information was essential for the correct understanding of the application.

Moreover, when a trade name is used for a group of companies, it cannot be equated to the use in the name of only one company.

The Respondent was under no obligation to investigate the circumstances of the application. Section 21.3 of the Sunrise Rules states that the validation agent may but is not obliged to conduct further investigations at its own initiative.

A company/trade name may only be used in the second phase of the sunrise period whereas this application was filed in the first phase. Therefore the applicant's reference to a company name was not accepted.

A domain name is not a prior right.

Information submitted for the first time during the present ADR proceedings may not be taken into consideration. The Complainant now argues that it is part of a group of companies which trade under the name of the applicant and submits evidence which allegedly proves that the applicant's name is a trade name. However, the Respondent may only accept documents received by the validation agent within 40 days from the submission of the application for the domain name. The complaint was submitted some months later. Accepting these documents as documentary evidence would violate Regulation (EC) No 874/2004.

Only the documentary evidence which the Respondent was able to examine at the time of validation of the application should be considered by the Panel to assess the validity of the Respondent's decision.

This verification is the only task for the Panel in these proceedings, which may not in any case serve as a "second chance" or an additional round providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise Period.

In order to benefit from this opportunity to demonstrate its prior rights, the applicant must comply with the strict procedure laid out by

Regulation (EC) No 874/2004. The applicant in the present case did not because its application did not correctly fulfill the substantive requirements.

Any right given to the Complainant to correct the applicant's defective application at this stage of the procedure would be unfair to the other applicants.

The fact that there has been only one application for the domain name MUSIC ROOM is irrelevant in determining whether the Respondent's decision conflicts with Regulation (EC) No 874/2004.

DISCUSSION AND FINDINGS

In accordance with Article 22(11) of Regulation (EC) 874/2004 ("the Regulation"), the Panel must decide whether the decision of the Respondent conflicts with the Regulation or with Regulation (EC) 733/2002.

Recital 12 of the Regulation explains the purpose of the phased registration period as follows: "In order to safeguard prior rights recognised by Community or national law, a procedure for phased registration should be put in place. Phased registration should take place in two phases, with the aim of ensuring that holders of prior rights have appropriate opportunities to register the names on which they hold prior rights. The Registry should ensure that validation of the rights is performed by appointed validation agents. On the basis of evidence provided by the applicants, validation agents should assess the right which is claimed for a particular name. Allocation of that name should then take place on a first-come, first-served basis if there are two or more applicants for a domain name, each having a prior right."

Article 10 (1) of the Regulation provides that holders of applicable prior rights were eligible to apply to register domain names during a period of phased registration before general registration of .eu started.

The procedure to be followed for validation and registration of applications received during the phased registration period is described in Article 14 of the Regulation. In particular, Article 14(1) states: "All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists". Article 14(4) states: "Every applicant shall submit documentary evidence that shows that he or she is the holder of the prior right claimed on the name in question…" and provides that this evidence must be submitted within 40 days of the application for the domain name. Article 14(7) states: "The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name…" Article 14(10) states: "The Registry shall register the domain name, on the first come first served basis, if it finds that the applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs."

Clearly, the Regulation places the burden of demonstrating prior rights on the domain name applicant. It was for the applicant to submit appropriate documentary evidence demonstrating ownership of the prior right within the 40 day time limit.

The Panel's role is to determine whether the Respondent's decision conflicted with the relevant regulations and not to consider the application afresh based on documents submitted for the first time in an ADR proceeding filed after that 40 day limit.

The Complainant says in the complaint that "The Music Sales Group" is a trading name for a group of companies including the Complainant and indeed this is supported by the sample headed notepaper annexed to the complaint. However, this document was not produced to the Respondent within the 40 day time limit.

In the Panel's view, as there was a mismatch between domain name applicant and domain name owner, it was at the least reasonable to expect the Respondent to check the application and supplied documentary evidence for obvious errors.

The only documentary evidence provided to the Respondent within the time limit was the CTM printout mentioned above. This identified the trade mark owner as "Music Sales Limited" whereas the applicant for the domain name was "The Music Sales Group". There was nothing in the documentary evidence indicating that "The Music Sales Group" was a trading name for a group of companies including the Complainant or indeed otherwise explaining the relationship between domain name applicant and trade mark owner. If there had been, the Panel would certainly have taken the view that the application should not have been rejected, notwithstanding that the trading name rather than the actual name of the legal entity was used in the domain name application and notwithstanding that the trading name in fact covered a number of other companies.

The Complainant suggests that the application might have been rejected because the postcodes in the domain name application and trade mark printout were different and explains that this arose from a reorganisation of postcodes in the Complainant's area which had

not been reflected in the trade mark proprietor details. But nothing turns on this because, even if the postcodes had been identical, the fact of the same address would not have indicated anything more than a likelihood of a connection of some kind between the two entities – not that one was a trading name for the other. If the documentary evidence had in fact given some indication of the relationship, then the similarity of the addresses (whether or not the postcode was different) might well have been an important factor.

The Complainant draws attention to another entity "Musicroom.com Ltd" and two domain names, musicroom.com and musicroom.co.uk, all of which were mentioned in the "prior right" field of the domain name application - in addition to the CTM. The Complainant appends to the complaint a printout of the company registration details for Musicroom Ltd and whois details for the two domain names, one of which is registered to "The Music Sales Group". Those documents cannot, however, assist the Complainant now because they were not provided to the Respondent within the 40 day limit. In any case, they contain nothing explaining the relationship between the domain name applicant and trade mark owner.

Furthermore none of those matters mentioned in the "prior right" field apart from the CTM were apt to create prior rights in respect of an application filed during the first phase of the sunrise period which was reserved for registered trademarks, geographical indications and the names and acronyms of public bodies – see Article 10(3) of the Regulation. (Indeed it is doubtful whether any of those matters would, of themselves, have sufficed in the second phase either.) The fact that "The Music Sales Group" is shown as the owner of musicroom.com in the domain whois annexed to the complaint is therefore irrelevant.

Finally, the Complainant relies on the decision in case 396 (CAPRI). The panel in that case did indeed find that the registry should have undertaken a degree of "public research" (the precise details of which were not specified). Many other cases have taken a different approach. See, eg, case 810 (AHOLD).

Ultimately, each case must depend on its own facts.

Here, the Complainant has not suggested - nor is it clear to the Panel - what investigations, if any, the Respondent might reasonably have been expected to undertake in this case beyond an examination of the domain name application and documentary evidence. Of the documents exhibited to the complaint, the only one explaining the relationship between domain name applicant and trade mark owner is the sample headed notepaper which was not publicly available.

For the above reasons, the Panel concludes that the decision taken by the Respondent did not conflict with Regulation (EC) 874/2004 or Regulation (EC) 733/2002.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint is Denied

PANELISTS

Name	Adam Taylor

DATE OF PANEL DECISION 2006-11-02

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The domain name application was in the name of "The Music Sales Group" whereas the relevant trade mark was in the name of "Music Sales Ltd". The addresses were identical apart from the postcode.

The Respondent rejected the domain name application on the grounds that the evidence was insufficient to demonstrate the existence of the prior right.

In the Panel's view, it was at the least reasonable to expect the Respondent to check the application and supplied documentary evidence for obvious errors. However, there was nothing in the documentary evidence submitted within the 40 day time limit which explained the relationship between domain name applicant and trade mark owner.

While the Complainant annexed to the complaint a document indicating that applicant name was a trading name for a group of companies including the Complainant, the Panel considered that its role was to determine whether the Respondent's decision conflicted

with the relevant regulations and not to consider the application afresh based on documents submitted for the first time in an ADR proceeding filed after that 40 day limit.

The Complainant had not suggested - nor was it clear to the Panel - what investigations, if any, the Respondent might reasonably have been expected to undertake in this case beyond an examination of the domain name application and documentary evidence. The only document annexed to the complaint explaining the relationship between domain name applicant and trade mark owner was one which was not publicly available.

The Panel concluded that the Respondent did not conflict with Regulation (EC) 874/2004 or Regulation (EC) 733/2002 and therefore denied the complaint.